

**Office of Intellectual Property Counsel
3M Innovative Properties Company**

**3M Center, PO Box 33427
St. Paul, MN 55133-3427 USA**

THE INFORMATION CONTAINED IN THIS FACSIMILE TRANSMISSION MAY CONTAIN CONFIDENTIAL OR LEGALLY PRIVILEGED INFORMATION INTENDED ONLY FOR THE PERSON OR ENTITY NAMED BELOW.

If you are not the intended recipient, please do not read, use, disclose, distribute or copy this transmission.

If this transmission was received in error, please immediately notify Sue Dacko by telephone directly at (651) 736-4638 and we will arrange for its return at no cost to you. Thank you.

FAX RECEIVED

OCT 14 2002

GROUP 3700

FACSIMILE

Date: October 14, 2002
Number of pages
including cover sheet: 4

To:
**Tech Center 3700
Group Art Unit 3761
Examine Aaron J. Lewis**

Your Ref: 09/680,465
Phone:
Fax No. 703-872-9302

From:
Karl G. Hanson

Our Ref: 48317US028
Phone: (651) 736-7776
Fax No. (651) 736-3833

Remarks:

Attached is a Response.

V. Douglas
10/18/02 Response
 Patent
 Case No.: 48317US028/10/17/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

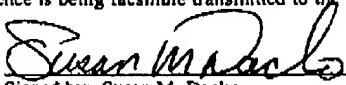
FAX RECEIVED

First Named Inventor: JAPUNTICH, DANIEL A.

Application No.:	09/680465	Group Art Unit:	3761	OCT 14 2002
Filed:	October 6, 2000	Examiner:	Aaron J. Lewis	GROUP 3700
Title:	FIBROUS FILTRATION FACE MASK HAVING A NEW UNIDIRECTIONAL FLUID VALVE			

RESPONSE

Commissioner for Patents
 Washington, DC 20231

<u>CERTIFICATE OF TRANSMISSION</u>			
To Fax No.: 703-872-9302			
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on:			
October 14, 2002		Signed by: Susan M. Dacko	
Date			

Dear Sir:

In response to the Office Action mailed July 17, 2002, applicants submit the following remarks.

The double-patenting rejection and the obviousness rejection based on Simpson and McKim cannot be sustained for the reasons presented in applicants' Amendment mailed April 26, 2002.

The Examiner has now rejected claims 60-63 as being unpatentable over Simpson in view of McKim and further in view of U.S. Patent 812,706 to Warbasse and U.S. Patent 4,934,362 to Braun. Applicants respectfully submit that this rejection cannot be sustained for the following reasons.

Although U.S. Patent 812,706 to Warbasse (published in 1906) has been referenced for teaching a valve cover that has a fluid-impermeable ceiling that increases in height in the direction of a flexible flap from a first end to the second end, Warbasse does not suggest the use of such a valve cover on an exhalation valve that is used in a filtering face mask that is adapted to fit over the nose and mouth of a person. Warbasse describes a device that is placed over a person's nose and is connected to a supply line tube 16. No teaching or suggestion has been identified, which would have motivated a person of ordinary skill to use Warbasse's hood element 11 in the Simpson valve shown in Figure 2. The Examiner indicates that "it would have been obvious to modify the valve (figure 2) of Simpson et al. to provide a valve in this (fig. 2) to provide a valve cover because it

Application No.: 09/680465

Case No.: 48317US028

would have provided a means for protecting the valve flap (12), controlling the extent of movement of the valve flap, controlling the direction of fluid flow exiting the mask via the valve as taught by Warbasse." Although there may be a variety of reasons for using a valve cover on the valve shown in Simpson, *the Examiner has not yet identified any particular suggestion of why a person of ordinary skill would have selected the hood element 11 in Warbasse's nose device for use on the exhalation valve shown in Figure 2 of Simpson.* As the Examiner is aware, the United States Patent and Trademark Office has the burden of providing *evidence* that shows why a person of ordinary skill would have combined the teachings in two different references. Mere conclusory statements generated by the Examiner do not qualify as *evidence*. In this regard, the Examiner's attention is again directed to *In re Lee* where the Federal Circuit explained that the motivation to combine references is a factual question that cannot be resolved on subjective beliefs of unknown authority.¹

The Examiner states that his reasons for combining Warbasse with Simpson are taught by Warbasse. But a review of this patent reveals that none of these reasons can be found anywhere in Warbasse. Some of those reasons, however, can be found in applicants' specification. For example, applicants state that the exhalation valve, "can be provided with a valve cover to protect the flexible flap" (see applicants specification, page 14, lines 33-35). Applicants also explain that the valve cover can allow the exhaled air to be "directed downwards to prevent fogging of the wearer's eyewear" (see applicants' specification at page 15, lines 5-8). It is, of course, improper to use applicants teachings against them in attempting to establish that a person of ordinary skill would have been led to the combination of references.² Perhaps these reasons may have been known in the art before applicants' filing date, but even so, the record still does not establish why a person of ordinary skill would have been motivated, in particular, to use Warbasse's hood element 11 on Simpson's valve over any of the multitudes of valve covers that have been previously described in the art.

The Braun patent adds little or nothing to the disclosure that is lacking in Simpson and McKim with respect to claims 60-63. The Braun patent does not teach or suggest a valve cover that has a fluid impermeable ceiling that increases in height in the direction of the flexible flap from the

¹ See *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) ("This factual question of motivation [to combine the references] is material to patentability and could not be resolved on subjective belief and unknown authority.").

² *In re Lee*, 61 USPQ2d at 1434 ("It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to [use] that which the inventor taught against its teacher.,"; see also, *W.L. Gore v. Garlock, Inc.*, 721 F2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983).

Application No.: 09/680465Case No.: 48317US028

first end to the second end. To the contrary, Braun does not even teach or suggest a fluid-impermeable ceiling. Braun only describes a grill 25, and this grill 25 does not have a fluid-impermeable ceiling that increases in height in the direction of the flexible flap from its first end to its second end. To the contrary, the grill 25 is located closer to the free end of the flap 24 relative to its fixed portion located at 19. Under such circumstances, Braun teaches away from applicants' invention and also provides very good evidence that the subject matter of claims 60-63 would not have been obvious to a person of ordinary skill.

The Examiner also has rejected claim 64 as being obvious, but this claim had previously been canceled by the applicants. In the Amendment mailed October 12, 2001, claims 58 and 64 had been canceled. Please note that these claims were previously designated as claims 59 and 65 but were renumbered by the Examiner because claim 57 was missing from the Preliminary Amendment dated October 3, 2000. Accordingly, the rejection based on claim 64 is no longer an issue. **The claims that are pending in this case should be as follows: 33, 35-57, 59-63, and 65-80.** Please note that in the Amendment filed on April 26, 2002, applicants had incorrectly designated the claims that are pending in this case. Applicants apologize for the confusion.

Respectfully submitted,

October 14, 2002
Date

By:


Karl G. Hanson, Reg. No.: 32,900
Telephone No.: 651-736-7776

Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427
Facsimile No.: 651-736-3833